



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,209	02/29/2000	Terry Allen-Rouman	00617425	1082

7590 10/31/2003

Darin J Gibby
Townsend and Townsend and Crew LLP
Two Embarcadero Center
8th Floor
San Francisco, CA 94111

EXAMINER

BASHORE, ALAIN L

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/516,209

Applicant(s)

ROUMAN ET AL.

Examiner

Alain L. Bashore

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-18, 24-27, 29-33, 35-37 and 39-46 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-18, 24-27, 29-33, 35-37 and 39-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21 . 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3-26-03 have been fully considered and are persuasive. The finality of previous office action has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14-15, 18, 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14-15, 18 recite an abbreviation (IOU) which is not previously defined in the claim.

Claims 39-43 recite "system" which is vague and indefinite since a system may be one of several different statutory classes of invention (including a method or an apparatus). Applicant must indicate on the record what statutory class of invention the system claims belong to. For the purposes of this examination these claims are considered apparatus.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 14-18, 24-27, 29-33, 35-37, 44-46 are rejected under 35 U.S.C. 101 as non-statutory. The method claims as presented do not claim a technological basis in the body of the claim. While the specification discloses such a basis, there is no basis claimed. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim at least one structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) – used only for content and reasoning since not precedential].

The use of “database” and “digital” per se does not preclude a non-computer method.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Walker et al.

Kolling et al discloses a method for facilitating an electronic purchase as the transferring funds from a payor to a payee (figure 4). Purchase information from a vendor and purchaser information from a purchaser are both received as payment information(122) from a funds transfer system. When the payment information is validated, the vendor is notified (130) and funds are transferred. The purchase information includes a purchase price, and the purchaser information includes an identification of a purchaser account. When the purchaser information is not validated (figure 7), a message is sent to the purchaser (46) and the purchaser is added to a database.

The funds transfer system is separate from the vendor system. The transfer of funds is from a user account to a vendor account where at least one of the accounts is a bank account. The user account may be a credit card account.

A funds transfer system is disclosed for paying in a transaction with a purchaser, wherein the vendor uses a vendor system and the purchaser uses a purchaser system during the transaction. A first and second connection is made between a vendor and purchaser system. Means for validating the transaction is disclosed. The means for validating include: a machine readable medium, means for receiving purchase information, means for receiving payment information, means for comparing, and means for paying. The means for paying may be an ACH. The means for receiving purchase information and means for receiving payment information may be a FTP over a network.

Kolling et al does not disclose:

 sending a digital IOU to the vendor after purchase validation, where the digital IOU is comprised of the purchase price and further redeeming the digital IOU; and,

Walker et al discloses sending an IOU (gift certificate) after purchase validation, where the IOU is comprised of the purchase price (col 8, lines 7-14) and further redeeming the IOU (col 8, lines lines 53-64). The IOU to Walker is considered "digital" since there is a digital characteristic associated with the IOU (certificate identifier).

It would have been obvious to one with ordinary skill in the art to include a digital IOU after purchase validation to Kolling et al for the purpose of buying a gift certificate by electronic purchase (i.e. substitution of one type of financial reimbursement for that disclosed by Kolling).

8. Claims 24-27, 39-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Rose et al.

Kolling et al discloses a method for facilitating an electronic purchase as the transferring funds from a payor to a payee (figure 4). Purchase information from a vendor and purchaser information from a purchaser are both received as payment information(122) from a funds transfer system. When the payment information is validated, the vendor is notified (130) and funds are transferred. The purchase information includes a purchase price, and the purchaser information includes an identification of a purchaser account. When the purchaser information is not validated (figure 7), a message is sent to the purchaser (46) and the purchaser is added to a database.

The funds transfer system is separate from the vendor system. The transfer of funds is from a user account to a vendor account where at least one of the accounts is a bank account. The user account may be a credit card account.

A funds transfer system is disclosed for paying in a transaction with a purchaser, wherein the vendor uses a vendor system and the purchaser uses a purchaser system during the transaction. A first and second connection is made between a vendor and purchaser system. Means for validating the transaction is disclosed. The means for validating include: a machine readable medium, means for receiving purchase information, means for receiving payment information, means for comparing, and means for paying. The means for paying may be an ACH. The means for receiving purchase information and means for receiving payment information may be a FTP over a network.

Kolling et al does not disclose validating payment info at the fund's transfer system (including use of payment information and purchase information comparisons).

Rose et al discloses confirmation at the funds transfer system using comparisons (col 8, lines 27-39).

It would have been obvious to one with ordinary skill in the art to include confirmation at the funds transfer system to Kolling et al because Rose et al teaches such confirmation as having an anti-fraud purpose (col 10, lines 15-29).

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Walker et al as applied to claims 14-17 above, and further in view of Rowney et al.

Kolling et al in view of Walker et al does not explicitly disclose comparing a digital signature.

Rowney et al discloses comparing digital signatures (col 15, lines 65-67; col 16, lines 1-23).

It would have obvious to one with ordinary skill in the art to modify Kolling et al to include confirming the digital IOU by comparing a digital signature since Rowney et teaches comparing digital signatures for security purposes (col 1, lines 30-36).

10. Claims 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Rose et al in further view of Rowney et al.

Kolling et al in view of Rose et al is rejected as set forth in the previous rejection.

Kolling et al in view of Rose et al does not explicitly disclose a method as being part of the check-out of the user with a vendor system.

Rowney et al discloses check-out of the user with a vendor system (col 11, lines 56-67; col 12, lines 1-24) and comparing digital signatures (col 15, lines 65-67; col 16,

lines 1-23).

It would have obvious to one with ordinary skill in the art to modify Kolling et al in view of Rose et al to include confirming the digital IOU by comparing a digital signature since Rowney et teaches comparing digital signatures for security purposes (col 1, lines 30-36).

It would have obvious to one with ordinary skill in the art to modify Kolling et al in view of Rose et al in view of Nielsen to include as part of the check-out of the user with a vendor system since Rowney et al teaches importance of assessing transaction risk (col 12, lines 5-6).

11. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Rose et al as applied to claims 24-27, 39-44 above, and further in view of Walker et al.

Kolling et al in view of Rose et al does not disclose funds in the form of gift certificates.

Walker et al discloses gift certificates (col 3, lines 33-67).

It would have been obvious to one with ordinary skill in the art to include funds in the form of gift certificates to Kolling et al in view of Rose et al because Walker et teaches advantages of gift certificates (col1, lines 44-67; col 2, lines 1-33).

12. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al in view of Rose et al in further view of Rowney et al as applied to claims 29-37 above, and further in view of Krishan et al.

Kolling et al in view of Rose et al in further view of Rowney et al does not disclose the requesting step causing a pop-up window to be opened.

Krishan et al discloses a requesting step causing a pop-up window to be opened (col 20, lines 1-7).

It would have been obvious to one with ordinary skill in the art to a requesting step causing a pop-up window to be opened to Kolling et al in view of Rowney et al because Krishan et al teaches pop-up windows function as attention providers (col 2, lines 40-42).

Response to Arguments

13. Applicant's arguments filed 3-26-03 have been fully considered but are not persuasive regarding "two transaction" argument for claims 24, 29, and 35. Kolling teaches use of an intermediary such that this would meet current recitations regarding transferring funds from a payor account to the funds transfer system to a payee account in two transactions.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nielsen discloses an IOU (discount coupon) where the IOU is digital (204).

Art Unit: 3624

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alain L. Bashore whose telephone number is 703-308-1884. The examiner can normally be reached on about 7:30 am to 5:00 pm (Alternate Fridays Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1113.


Alain L. Bashore
April 17, 2003